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| 09/863,476 | 05/24/2001 | Yasuhiro Shinkai | Q64648 | 1262 |
| 7590 06/08/2006 | | | | |
| SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037 | | | EXAMINER NGUYEN, TAN D | |
| | | | ART UNIT 3629 | PAPER NUMBER |

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,476

Applicant(s)

SHINKAI, YASUHIRO

Examiner

Tan Dean D. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 4/4/06 has been entered.

Claim Status

Claims 1-13, 15-18 are active and are rejected below. Claim 14 has been canceled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 10 (method¹), 1-5, 16-18 (apparatus¹) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) TAMURA et al (US Patent 6,771,896).

As for Independent method¹ claim 10, which basically is a method for accepting an order for a service, printing images on the basis of digital image data, comprising of the steps:

(a) transferring information, including ordered image data and order information, to a printer for printing the image; and

(b) instructing another printer, a voucher printer, to print a voucher including thumbnail images prepared on the basis of high-precision image data and details of the order on the basis of the order information, wherein the thumbnail images corresponding to image data which have transferred to the image printer.

Similarly, TAMURA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1st printer ordered image data and order information, {see Fig. 3, 223 or Fig. 4, 220, col. 9, lines 18-32}; and

(b) printing a voucher copy (or coupon or order evidence or receipt) to be given to the user when an order is received from the use {see Fig. 12, 212, or col. 9, lines 25-32}. As for the limitation of a voucher printer to print a voucher or receipt, this is inherently included in the system of TAMURA et al to produce a printed receipt copy.

Note that on col. 20, lines 33-47, TAMURA et al also discloses the concept of confirming a content of the order by selecting a preview mode on the parent camera to show thumbnail images corresponding to images for which prints are desired as index image and print these (a) thumbnail images using printer (130) of Fig. 12 to inherently produce hard copies of the thumbnail images. Note that on col. 10, lines 45-50,

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TAMURA et al also teaches that the print information include (b) designated images to be printed, print size information, number of prints, print finish information, etc.

Therefore, it would have been obvious to modify the teachings of TAMURA et al by changing the printer of step (b) from order of evidence function to confirming the content of the order including (a) thumbnail images and (b) order information as taught in col. 20, lines 33-47 and col. 10, lines 45-50 if confirming content of the order on a hard copy is desired. TAMURA et al fairly teaches the claimed invention except for a voucher printer which is separate from the image printer. However, it's well known to a skilled artisan, that adding a 2nd printer to perform a similar printing job of printer (130) would have been obvious to a skilled artisan if being efficient is more important than the cost of installing a 2nd printer to perform a single job than the multiple printing jobs of a single printer. Note that the separation of the two printing jobs are also taught in Fig. 4 wherein the printing jobs are printing image by printer 220 and coupon/receipt by item 212.

As for independent apparatus¹ claim 1, which is the apparatus to carry out the method of claim 10, it's rejected over system of TAMURA et al in claim 10. Moreover, it would have been obvious to a skilled artisan, to select the appropriate system to carry out the steps of claim 10 as rejected over TAMURA et al.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or

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structures. Moreover, this is also taught in TAMURA et al as indicated in claim 10 above.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 13 (a), 13 (b), and/or Fig. 4 (224).

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 13(a), 13(b) or Fig. 12 or 9. Note also that the type of images received is non-essential to the scope of the claimed invention since it appears that it can receive any type of images.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in TAMURA et al col. 20, lines 40-49.

As for dep. claims 17-18 (part of 1), which deal with how the voucher printer operates, these have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

4. **Claims 10 (method¹), 1-5, 16-18 (apparatus¹), 11-13 (method²), 6-9, 12 and 15 (apparatus²), are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) TAMURA et al (US Patent 6,771,896), (2) DAWE (Article 9/29/98). and (3) CHUI et al (US Patent 6,657,702).**

As for Independent method¹ claim 10, the teachings of TAMURA et al is cited above. DAWE is cited to teach well known benefits of confirming an order for ordering an item (or service) on a hard copy (written confirmation or paper) sent to the customer (person who has placed the order) by confirming the details of the order requested, providing price quotation and notifying customers of any upgrades that have been take place for the benefits of (1) minimizing errors and (2) reassure customers and/or (3) ironing out any errors prior to delivery of the ordered item/service {see page 2, paragraphs 2-5}.

In a similar facility for ordering photographic print, CHUI et al discloses the concept of viewing the ordered digital images by (1) viewing the digital images on a computer display (Fig. 1, (107)), or printed hard copies (physical prints) made of digital images by output devices such as inkjet printer {see col. 1, lines 57-65}. It would have been obvious to modify the teachings of TAMURA et al by confirming an order by printed hard copies of the details of the orders as taught by DAWE and CHUI et al in order to obtain at least one of the well known benefits for confirming an order as cited by DAWE above.

As for the limitation of a voucher printer which is separate from the image printer, it's well known to a skilled artisan, that adding a 2nd printer to perform a similar printing

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job of printer (130) of TAMURA et al would have been obvious to a skilled artisan if being efficient is more important than the cost of installing a 2nd printer to perform a single job than the multiple printing jobs of a single printer. Note that the separation of the two printing jobs are also taught in TAMURA et al, Fig. 4 wherein the printing jobs are printing image by printer 220 and coupon/receipt by item 212.

As for independent apparatus¹ claim 1, which is the apparatus to carry out the method of claim 10, it's rejected over system of TAMURA et al/DAWE /CHUI et al in claim 10. Moreover, it would have been obvious to a skilled artisan, to select the appropriate system to carry out the steps of claim 10 as rejected over TAMURA et al /DAWE /CHUI et al.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or structures. Moreover, this is also taught in TAMURA et al as indicated in claim 10 above.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 13 (a), 13 (b), and/or Fig. 4 (224).

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 13(a), 13(b) or Fig. 12 or 9. Note also that the type of images received is non-essential to the scope of the claimed invention since it appears that it can receive any type of images.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in TAMURA et al col. 20, lines 40-49.

As for dep. claims 17-18 (part of 1), which deal with how the voucher printer operates, these have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for Independent method² claim 11, which basically is a method for accepting an order for a service, printing images on the basis of digital image data, comprising of the steps:

(a) transferring ordered image data and order information to a printer for printing the image;

after the order has been placed,

(b) transmitting information in the form of electronic mail containing thumbnail (tiny) images to a person who has placed the order, wherein the thumbnail images are

prepared on the basis of high-precision image data corresponding to image data and order information which has been transferred to the image printer.

Similarly, TAMURA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1st printer (Fig. 3, 223 or Fig. Fig. 12, 130) ordered image data and order information, {see Fig. 3, 211, col. 9, lines 18-32};

after the order has been placed {see col. 11, line 45};

(b) transmit information in the form of e-mail to the user telling completion of prints {see col. 13, lines 10-12}.

TAMURA et al fairly teaches the claimed invention except for step (b) wherein the information including ordered items, i.e. thumbnail images prepared on the basis of high-precision image data and the order information.

The teachings of DAWE is cited above. CHUI et al is cited to teach the viewing of digital images by (1) viewing the ordered digital images on a computer display (Fig. 1, (107)), or printed hard copies (physical prints) made of digital images by output devices such as inkjet printer {see col. 1, lines 57-65} or by sending them to the user in the form of an electronic mail or e-mail on the Internet {see col. 1, lines 45-67, col. 17, lines 25-40, col. 21, lines 40-50, or Fig. 9. It would have been obvious to modify the teachings of TAMURA et al by confirming the details of the orders as taught by DAWE and through e-mail as taught CHUI et al in order to obtain at least one of the well known benefits for confirming an order as cited by DAWE above and well known benefits of the e-mail through the Internet such as convenience, fast or low cost.

As for dep. claim 13 (part of 11 above), this is taught in CHUI et al Fig. 9 or col. 17, lines 25-40 or TAMURA et al col. 13, lines 10-11.

As for independent apparatus² claim 6, which is the apparatus to carry out the independent method¹ of claim 11 above, the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein (a) the image printer is element (220 or 130), and (b) the electronic mail transmission means which communicates with the person who has placed an order and in the form of an electronic mail is shown described on col. 13, lines 10-13 or CHUI et al Fig. 9, col. 1, lines 45-67, col. 17, lines 25-40, col. 21, lines 40-50.

As for dep. claims 7, 8, 9 (part of 6 above), these are fairly taught in CHUI et al Figs. 9 or 5.

As for dep. 12 (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

As for dep. 15 (part of 6), TAMURA et al discloses the communication with the user/client using portable cellular phone {see c9:47-50}. The use of other similar/equivalent portable phone for displaying images if desired would have been obvious as merely using other similar/equivalent device to achieve similar/equivalent results, absent evidence of unexpected results. Surely, an image display is normally better than a text/data display or would have been obvious if an image display is desired.

5. Dep. claim 15 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over TAMURA et al /DAWE /CHUI et al as applied to claims 6-9, 12 above, and further in view of CONE et al or NARAYANASWAMY et al.

The teachings of TAMURA et al/DAWE /CHUI et al is cited above. TAMURA et al teaches the communication with the user/client using portable cellular phone {see c9:47-50}. CONE et al or NARAYANASWAMY et al is cited to teach the use of portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network {see CONE et al Fig. 1, or 2 or [0004, 0021], or NARAYANASWAMY et al Fig. 1A, 1B or Fig. 4, col. 2, lines 20-30}. It would have been obvious to modify the portable cordless phone of TAMURA et al / DAWE / CHUI et al by using portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network as taught by CONE et al or NARAYANASWAMY et al to allow viewing of virtual image of video information if desired.

Response to Arguments

6. Applicant's arguments, see response, filed 4/4/06, with respect to claims 1-13, 15-18 have been fully considered and are persuasive. The 103 rejections of claims 1-13, 15-18 over TAMURA et al /FUJI et al/DAWE have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of CHUI et al.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 6,167,382 discloses a design and production of print materials over the Internet.

2) US 6,583,799 discloses an image uploading with thumbnail images online.

3) US 6,812,961 discloses a system and camera for automatically forwarding digital images to a service provider.

4) US 6,324,521 discloses a network for photograph service on the Internet.

5) US 2001/0016824 discloses system and method for management of small size information devices such as digital camera.

No claims are allowed.

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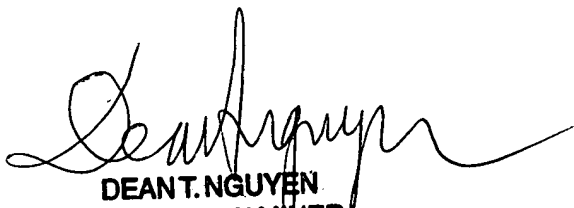
8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
June 6, 2006



DEAN T. NGUYEN
PRIMARY EXAMINER